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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/245,798
Filing Date: February 05, 1999
Appellant(s): O'DONNELL ET AL.

Mike O'Donnell et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/17/2008 appealing from the Office action mailed 07/05/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Johnson et al. (U.S. 5,991,876)

Elsevier Science (www.elsevier.com).

Holmes et al. (U.S. 6,119,108)

Digital Object Identifier (DOI) system, disclosed by the references:

i. Article "STM houses, CCC showcase latest DOI prototype via AAP" by Calvin Reid (referred to herein as reference A);

ii. Article "Metadata for the Millennium" by James Lichtenberg (referred to herein as reference B);

iii. Article "AAP unveils DOI as PSP Confab" by Calvin Reid (referred to herein as reference C);

iv. Article "Association of American Publishers proposes a digital object identifier (DOI) or electronic access to publications" from *Information Intelligence, Online Libraries, and Microcomputers* (referred to herein as reference D).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 126-127, 129-131, 138, and 145 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (U.S. 5,991,876).

As per claim 126, Johnson et al. discloses a clearinghouse server system method for receiving from publishers of works of authorship offers of licenses, presenting the offers to potential licensees, and, in response to acceptances, without intermediate human activity, transmitting a copy of a work, comprising:

(a) presenting on a computer network license offering registration web pages usable by a plurality of publishers to enter for each of a plurality of works of authorship information to identify the work and all terms for offering a license to make a use of the work (See figures 5-6, column 3, lines 1-17 and 25-58, column 4, lines 55-67, table 4, column 8, lines 45-57, column 9, lines 55-67, and column 10, lines 17-40, wherein works are registered by a plurality of publishers to identify the work and terms of the work);

(b) receiving on the registration web pages from a first computer and a second computer on the network information for a first registration record for a first work of authorship from a first publisher and for a second registration record for a second work of authorship from a second publisher (See figures 4-6, column 2, line 63-column 3, line 17, column 4, lines 55-67, table 4, column 8, lines 45-57, column 9, lines 55-67, and column 10, lines 17-40, wherein a network is used and a first and second registration record are recorded);

(c) storing on the server system a first registration record and a second registration record, the data stored in the first registration record specifying an identifier of the first work of authorship and all terms for offering to license the first work of authorship (See the abstract, figure 4, column 2, line 63-column 3, line 17, column 5, lines 12-30, column 7, lines 1-11 and 40-55, column 8, lines 10-20 and 35-44, wherein registration records are stored on the server system with the licensing terms);

(d) receiving from a third computer on the network the identifier of the first work of authorship and, in response, presenting to the third computer a license offering web page incorporating all of the terms for offering a license to make a use of the first work of authorship (See figures 2 and 7, column 4, lines 55-67, column 9, line 55-column 10, line 15 and lines 41-60, wherein an offer is presented to the user over the internet using the client/server architecture);

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and responding to the third computer with a message that the acceptance has been received and acknowledged, and, as a consequence of having received the message indicating acceptance of the offered terms, allowing the third computer via the network access to use of an electronic copy of the first work of authorship (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60, wherein the third computer (the client) accepts the terms and the acceptance is acknowledged. See also figure 7, column 7, lines 1-10 and 40-55, column 9, lines 35-55, column 10, lines 40-60, wherein the third computer/client accesses and uses an electronic copy of the work for use).

However, Johnson et al. does not expressly disclose also receiving a request for an electronic copy and that the third computer being sent via the network an electronic copy of the first work of authorship as a consequence of having received the message.

Johnson et al. teach electronic rights systems that allow for enforcement of copyrights associated with published documents and also allows for the obtainment of rights to use these documents. Johnson et al. discloses that once the third computer (the client) accepts the terms and the acceptance is acknowledged the third computer/client is allowed to access and use an electronic copy of the work via the network. Examiner takes official notice that it is well-known

to transmit a copy of a work to a user after he has secured rights to use such a work, such as by electronic means, so that the user may have a copy of the work to use. It would have been obvious to one of ordinary skill in the art at the time of the invention to send via the network an electronic copy of the first work of authorship in order to more accurately account for all the aspects of conferring right (i.e. types of use, etc.) by providing fully automated rights management and authorization. See column 2, lines 40-67, column 9, lines 35-55, column 10, lines 40-60, of Johnson et al., which discloses electronic use of a document.

As per claim 127, Johnson et al. teaches wherein the electronic copy includes electronically coded text (See figure 7, column 7, lines 1-10 and 40-55, column 9, lines 35-55, column 10, lines 40-60, wherein an electronic copy of written works, for example, would be electronically coded text).

As per claim 129, Johnson et al. teaches claim 129, elements (a)-(d). Claim 129, elements (a)-(d) are substantially similar to claim 126, elements (a)-(d), and therefore are rejected using the same art and rationale set forth above in the rejection of claim 126 above. Johnson et al. further discloses:

presenting on a publicly accessible computer network license offering registration web pages (See figures 5-6, column 3, lines 1-17 and 25-58, column 4, lines 55-67, table 4, column 8, lines 45-57, column 9, lines 55-67, and column 10, lines 17-40, wherein works are registered by a plurality of publishers to identify the work and terms of the work);

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and responding to the third computer with a message that the acceptance and request have been received and acknowledged (See figures 2 and 7, column 3, lines 25-55,

column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60, wherein the third computer (the client) accepts the terms and the acceptance is acknowledged);

(f) storing a record of the accepted license and making the record available for look-up from a computer on the publicly accessible network (Column 3, lines 44-57, column 8, lines 1-20, column 9, lines 35-67, wherein the record is stored and accessible in the system).

However, Johnson et al. does not expressly disclose making the record of the license available to anyone from any computer on the publicly accessible network.

Johnson et al. discloses storing records of accepted licenses and terms of these licenses in the system, wherein the records are available for look-up from a computer on the Internet. Johnson et al. further discloses allowing potential licensees to access the system over a network, like the Internet. It is well known in network security that the availability of a database to be accessed over a network is based on the security settings associated with such data. It would have been obvious to one of ordinary skill in the art at the time of the invention to include low security settings, allowing anyone to access the records concerning licensing agreements in order to more efficiently reduce the illegal use and distribution of copyrighted works by allowing a member of the public to have enough information to verify whether a work is licensed or not, thus allowing the member to contact appropriate persons if the used work is not licensed.

As per claim 130, Johnson et al. teaches wherein the step of presenting license offering registration web pages is performed by a server in the server system and the step of presenting to the third computer a licensing web page is performed by a server in the server system (See figure 2, abstract, column 3, lines 45-60, column 4, lines 45-67, column 9, line 55-column 10, line 15). However, while Johnson et al. discloses a network with client/server functionality and multiple

computers, Johnson et al. does not expressly disclose multiple servers in this client/server network.

A server is merely a computer on a network that "serves" data to the rest of the network. Since Johnson et al. discloses a network with client/server functionality and multiple computers it would have been obvious to one of ordinary skill in the art at the time of the invention to include multiple servers that share the functions of the network in order to increase the efficiency of the network by performing load balancing. See column 11, lines 19-25, wherein the design choices for the system are left up to the programmer, etc.

As per claim 131, Johnson et al. teaches wherein functions of the server system are distributed across a plurality of physical computers and at least one of the server system steps is performed in the first computer (See figure 2, abstract, column 3, lines 45-60, column 4, lines 45-67, column 9, line 55-column 10, line 15, wherein the function of the server system are distributed).

Claim 138 is substantially similar to claim 126, and is therefore rejected over Johnson et al. using the same rationale set forth above. Johnson et al. further teaches a database component that stores the registrations (See column 2, line 63-column 3, line 5, column 4, lines 35-60).

Claim 145 is substantially similar to claim 129, and is therefore rejected over Johnson et al. using the same rationale set forth above. Johnson et al. further teaches a database component that stores the registrations (See column 2, line 63-column 3, line 5, column 4, lines 35-60).

Claims 128, 142, and 146-147 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (U.S. 5,991,876) in view of Elsevier Science (www.elsevier.com).

As per claim 128, Johnson et al. teaches claim 128, elements (a)-(d). Claim 128, elements (a)-(d) are substantially similar to claim 126, elements (a)-(d), and therefore are rejected using the same art and rationale set forth above in the rejection of claim 126 above.

Johnson et al. further discloses:

(e) receiving from the third computer on the network a message indicating acceptance of the offered terms and responding to the third computer with a message that the acceptance and request have been received and acknowledged (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60, wherein the third computer (the client) accepts the terms and the acceptance is acknowledged);

(f) after the message indicating acceptance is received, as a consequence of having received the acceptance, the clearinghouse server system processes the order and allows copying of the work of authorship for printing on paper (See figure 7, column 7, lines 40-55, column 8, lines 1-22, column 9, lines 35-55, column 10, lines 40-60, wherein the third computer/client request the order of paper copies be supplied).

Johnson et al. further discloses that educational institutions are rights holders that make copies and course packets (See column 2, lines 5-20, column 3, lines 5-15, column 7, lines 40-55, and column 8, lines 15-22, wherein educational institutions make copies in the form of course packets).

However, Johnson et al. does not expressly disclose that the user requests that a paper reprint be delivered, sending a copy to a printer, or delivering the copy.

Elsevier Science discloses that the user requests that a paper reprint be delivered and delivering the copy (See pages 2-3).

However, while Elsevier Science allows users to request published material and have that material delivered, Elsevier Science does not expressly disclose sending a copy to a printer.

Johnson et al. discloses that an authorized user requests the right to make paper copies, via the clearinghouse system (which processes the order). Johnson et al. further discloses storing information about the authorized user, such as the user's address. Johnson et al. further discloses an educational institution making copies of course packets based on permissions granted to make copies. The educational institution would have a copy from which they would print multiple paper copies for use by students. Elsevier Science discloses ordering/requesting a copy of a publication that is a paper reprint that is delivered. It is well known with copyrights and publishing that clean copies are provided to users from which to make copies, such as with Elsevier Science. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to request a paper reprint/copy of the work and supply/deliver this copy to the rights holder in order to increase customer service and the usability of the system by having the publishing system send a copy to the user from which to make copies.

Further, examiner takes official notice that systems that provide requested publications make copies of these publications at their printers before sending these copies to requesters (i.e. a system that allows users to request copies of publications and have that material delivered would have to makes copies before sending copies). Therefore, it would have been obvious to one of

ordinary skill in the art at the time of the invention to send a copy to a printer before sending out the copy to the requester of Elsevier Science in order to increase the processing speed of the system of providing publications to requesting users. See page 2 of Elsever Science.

Claim 142 is substantially similar to claim 128, and is therefore rejected over Johnson et al. using the same rationale set forth above. Johnson et al. further teaches a database component that stores the registrations (See column 2, line 63-column 3, line 5, column 4, lines 35-60).

As per claims 146-147, Johnson et al. discloses works of publishers, such as stories and anthologies (See column 8, lines 35-57) and securing rights to use these works, such as to make copies (See figure 7, column 7, lines 40-55, column 8, lines 1-22, column 9, lines 35-55, column 10, lines 40-60). Johnson et al. does not expressly disclose a copy being sent to a printer. Elsevier Science teaches wherein the copy sent to a printer (See pages 2-3). However, Elsevier Science does not expressly disclose that this copy includes a human readable message indicating the name of the publisher of a first work of authorship.

Johnson et al. discloses that an authorized user requests the right to make paper copies, via the clearinghouse system (which processes the order). Johnson et al. further discloses storing information about the authorized user, such as the user's address. Johnson et al. further discloses an educational institution making copies of course packets based on permissions granted to make copies. The educational institution would have a copy from which they would print multiple paper copies for use by students. Elsevier Science discloses ordering/requesting a copy of a publication that is a paper reprint that is delivered. It is well known with copyrights and publishing that clean copies are provided to users from which to make copies, such as with Elsevier Science. Therefore, it would have been obvious to one of ordinary skill in the art at the

time of the invention to request a paper reprint/copy of the work and supply/deliver this copy to the rights holder in order to increase customer service and the usability of the system by having the publishing system send a copy to the user from which to make copies.

Examiner further takes official notice that it is old and well known to list the publisher on a printed story, article, publication, and/or anthology in order to preserve the rights and the identity of the work. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the publisher name in a human readable way on the work in order to more accurately preserve the rights and the identity of the work, thus allowing a user of the work to also know who to contact to get rights to the work.

Claims 133 and 139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (U.S. 5,991,876) in view of Holmes et al. (U.S. 6,119,108).

As per claim 133, Johnson et al. teaches making an electronic copy with permission of an owner of copyrights in the first work of authorship (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60). However, Johnson et al. does not expressly disclose that the electronic copy includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

Holmes et al. discloses that the electronic copy includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship (See figure 2).

Both Johnson et al. and Holmes et al. teach electronic rights systems that allow for enforcement of copyrights associated with published documents and also allow for the obtainment of rights to use these documents. Johnson et al. discloses allowing the user to make copies of the document, as per the licensing agreement. Marking reproduced, copyright material with a disclaimer is well known in the art of licensing. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the message of Holmes et al. that indicates the copy was made with permission of an owner of copyrights in order to more efficiently decrease the illegal use and distribution of copyrighted works and thus ensure that copyright holders receive their appropriate fees. See column 1, lines 5-15, and column 2, lines 5-25, of Holmes et al. that discuss the importance of stopping illegal reuse of copyrighted materials.

Claim 139 recites equivalent limitations to claims 133 and is therefore rejected using the same art and rationale as set forth above.

Claims 136-137 and 143-144 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (U.S. 5,991,876) in view of Elsevier Science (www.elsevier.com) and in further view of Holmes et al. (U.S. 6,119,108).

As per claim 136, Johnson et al. teaches making an electronic copy with permission of an owner of copyrights in the first work of authorship (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60). However, Johnson et al. does not expressly disclose, nor does Elsevier Science, that the electronic copy includes a

human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship.

Holmes et al. discloses that the electronic copy includes a human readable message indicating that the copy was made with permission of an owner of copyrights in the first work of authorship (See figure 2).

Johnson et al. and Elsevier Science both disclose providing access to works of authorship and are combinable for the reasons set forth above with regards to claim 128. Further, both Johnson et al. and Holmes et al. teach electronic rights systems that allow for enforcement of copyrights associated with published documents and also allow for the obtainment of rights to use these documents. Johnson et al. discloses allowing the user to make copies of the document, as per the licensing agreement. Marking reproduced, copyright material with a disclaimer is well known in the art of licensing. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include the message of Holmes et al. that indicates the copy was made with permission of an owner of copyrights in order to more efficiently decrease the illegal use and distribution of copyrighted works and thus ensure that copyright holders receive their appropriate fees. See column 1, lines 5-15, and column 2, lines 5-25, of Holmes et al. that discuss the importance of stopping illegal reuse of copyrighted materials.

As per claim 137, Johnson et al. teaches a copy being made with permission of an owner of copyrights in the first work of authorship (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60). However, Johnson et al. does not expressly disclose, nor does Elsevier Science, that the copy includes a network address

of a webpage containing an indication verifying that the copy was made with permission of the owner of copyrights in the first work of authorship.

Holmes et al. discloses that a copy of the work includes a human readable message indicating and verifying that the copy was made with permission of an owner of copyrights in the first work of authorship (See figure 2). However, Holmes et al. does not expressly disclose that this message includes a network address of a webpage.

Johnson et al., Elsevier Science, and Holmes et al. are combinable for the reasons set forth above with regards to claim 136. Holmes et al. further discloses a message on a copy of a work indicating that the document was recreated and/or distributed in coherence with the terms and conditions agreed to at the time of purchase. It would have been obvious to one of ordinary skill in the art at the time of the invention to include a network address of a webpage in the this message in order to more accurately maintain the formatting and look of the original document by reducing the amount of text added around the document. See column 5, lines 45-60, of Holmes et al., which discloses the importance maintaining the look of the original document.

Claims 143 and 144 recite equivalent limitations to claims 136 and 137, respectively, and are therefore rejected using the same art and rationale as set forth above.

Claim 132, 134-135, and 140-141 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (U.S. 5,991,876) in view of Digital Object Identifier (DOI) system. The following references disclose aspects of the DOI system:

i. Article "STM houses, CCC showcase latest DOI prototype via AAP" by Calvin Reid (referred to herein as reference A);

ii. Article "Metadata for the Millennium" by James Lichtenberg (referred to herein as reference B);

iii. Article "AAP unveils DOI as PSP Confab" by Calvin Reid (referred to herein as reference C);

iv. Article "Association of American Publishers proposes a digital object identifier (DOI) or electronic access to publications" from *Information Intelligence, Online Libraries, and Microcomputers* (referred to herein as reference D).

As per claim 132, Johnson et al. teaches publishing a work of authorship and allowing a user of the third computer to click on a hot spot that allows the user to obtain the rights to the work of authorship (See figure 7, column 2, lines 20-55, column 8, lines 5-22, and column 10, lines 40-60). However, Johnson et al. does not expressly disclose and the DOI system discloses that the work is published from a server on the network with the identifier of the first work embedded such that, when the first work of authorship is displayed on the third computer and a user of the third computer clicks on a hot spot in the work of authorship, the embedded identifier is used to form a network address that links the third computer to the license offering web page for the first work of authorship (See at least reference A, page 1, section 2, reference B, page 2, sections 2-4, and reference C, page 1, sections 2-3, wherein the user encounters a digital work on the network and the user clicks of the DOI graphic, which links the user to a licensing page associated with the work).

Johnson et al. discloses a user viewing a published work and a network based server system with a hotspot that a user accesses to link to the terms and rights of a license in at least

figure 7, column 2, lines 20-55, column 8, lines 5-22, column 9, lines 57-67, and column 10, lines 40-60. The DOI system discloses hotspots located directly in the work that the requesting user wishes to license, clicking on hotspots to link to licensing webpages, and using a presented licensing web page associated with the work to accept the offered license terms. Examiner points out that reference A discloses the DOI system used by the Copyright Clearance Center, who is the assignee of the Johnson et al. patent. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to integrate the hot spot into the published work enable the user to access the registration webpage and accept the terms in order to increase the ease of use of the system for the consumer by placing a link by which the user can automatically and efficiently accept the terms. See at least reference B, page 2, sections 1-4, and reference D, section 1, which discusses increasing the ease with which the consumer can identify the owner of a work of authorship and license said work.

As per claim 134, Johnson et al. teaches making an electronic copy with permission of an owner of copyrights in the first work of authorship (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60). However, neither Johnson et al. does not expressly disclose that the electronic copy includes a network address of a web page containing an indication verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

The DOI system discloses a DOI graphic included in an electronic copy of a document, the DOI graphic including a network address of a web page, the web page verifying that the publisher is aware of the copy (i.e. through the showing of the graphic), which links the user to a

licensing page associated with the work (See reference A, page 1, section 2, reference B, page 2, sections 1-4, reference C, page 1, section 3).

Johnson et al. teaches electronic rights systems that allow for enforcement of copyrights associated with published documents and also allow for the obtainment of rights to use these documents. Johnson et al. discloses allowing the user to make copies of the document, as per the licensing agreement. Marking reproduced, copyright material with a disclaimer is well known in the art of licensing. The DOI system discloses icons located directly in the work, the icon containing an address that links to a webpage with the rights information associated with the work. Examiner points out that reference A discloses the DOI system used by the Copyright Clearance Center, who is the assignee of the Johnson et al. patent. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to integrate an address into a work to enable the user to verify that the copy was made with permission of the owner in order to in order to more efficiently decrease the illegal use and distribution of copyrighted works and ensure that copyright holders receive their appropriate fees by implementing efficient means by which works can be checked and verified.

As per claim 135, Johnson et al. teaches making an electronic copy with permission of an owner of copyrights in the first work of authorship (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60). However, Johnson et al. does not expressly disclose that the electronic copy includes a hotspot, that, when selected by a user when the electronic copy is displayed on a computer display, causes a browser to send a retrieve request to the network address of the web page containing a message verifying that the copy was made with permission of an owner of copyrights in the first work of authorship.

The DOI system discloses a hotspot (i.e. DOI graphic) included in an electronic copy of a document, the hotspot when selected causing a browser to link to a network address of a web page, the web page verifying that the publisher is aware of the copy (i.e. through the showing of the graphic), which links the user to a licensing page associated with the work (See reference A, page 1, section 2, reference B, page 2, sections 1-4, reference C, page 1, section 3).

Johnson et al. teaches electronic rights systems that allow for enforcement of copyrights associated with published documents and also allow for the obtainment of rights to use these documents. Johnson et al. discloses allowing the user to make copies of the document, as per the licensing agreement. Marking reproduced, copyright material with a disclaimer is well known in the art of licensing. The DOI system discloses icons located directly in the work, the icon containing an address that links to a webpage with the rights information associated with the work. Examiner points out that reference A discloses the DOI system used by the Copyright Clearance Center, who is the assignee of the Johnson et al. patent. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to integrate an address into a work to enable the user to verify that the copy was made with permission of the owner in order to in order to more efficiently decrease the illegal use and distribution of copyrighted works and ensure that copyright holders receive their appropriate fees by implementing efficient means by which works can be checked and verified.

Claims 140-141 recite equivalent limitations to claims 134-135 and are therefore rejected using the same art and rationale as set forth above.

(10) Response to Argument

In the Appeal Brief, Appellant presents the following arguments:

1) As per claims 128 and 145, Johnson does not teach making a record available for lookup by anyone and explicitly teaches away from making it accessible to anyone;

2) As per claims 128 and 145, there is no teaching, suggestion, or motivation found in Johnson to make the change suggested by Examiner;

3) As per claims 126 and 138, Johnson does not teach or suggest that a person can place an order for, request, or receive a "copy" of a work of authorship; the only deliverables in Johnson are rights;

4) As per claims 126 and 138, there is no teaching, suggestion, or motivation found in Johnson and no knowledge generally available to one of ordinary skill in the art to make the change suggested by Examiner;

5) As per claims 128 and 142, the combination of Johnson and Elsevier would not produce the claimed invention because nether reference teaches that an electronic copy might automatically be sent to a printer and examiner's assertion that Johnson mentions educational institutions making copies does not teach or suggest allowing users to place orders for copes of works of authorship or delivering ordered copies.

In response to argument 1), Examiner respectfully disagrees. The claim recites making the record available for look-up by anyone from any computer on the publicly accessible network. Therefore, the record can be viewed by any user in the network. Johnson et al. discloses **a publicly accessible network** and **storing a record of the accepted license** and

making the record available for look-up from a computer on the publicly accessible network of at least the Internet (Column 3, lines 44-57, column 8, lines 1-20, column 9, lines 35-67). Johnson et al. further discloses in column 3, lines 44-57 that potential licensees are allowed to access the system over a network, like the Internet. Examiner asserted that it is well known in network security that the availability of a database to be accessed over a network is based on the security settings associated with such data. Applicant has not traversed this assertion and has not challenged examiner's official notice in the preceding or current remarks. In fact, in the current Appeal Brief, Applicant states on page 17 that "although this change from the prior art can easily be made by a programmer". Therefore, since the record is accessible via a publicly accessible network, and since it is well known that who can access the records is based on security settings, Examiner maintains that it would have been obvious to one of ordinary skill in the art at the time of the invention to include low security settings, allowing anyone to access the records concerning licensing agreements. Changing the security settings would have led to predictable results. Further, Examiner does not feel that Johnson et al. teaches away from allowing anyone on the publicly accessible network access to records of the database since Johnson et al. discloses allowing potential licensees to access the system as well as the network being the Internet, and since users being able to access the database are based on security settings.

In response to argument 2), Examiner points out that there is a teaching, suggestion, or motivation found in Johnson to make the change suggested by Examiner Johnson et al. Examiner established that it would have been obvious to one of ordinary skill in the art at the time of the invention to send via the network an electronic copy of the first work of authorship in order to more accurately account for all the aspects of conferring right (i.e. types of use, etc.) by

providing fully automated rights management and authorization. See column 2, lines 40-67, column 9, lines 35-55, column 10, lines 40-60, of Johnson et al., which discloses electronic use of a document.

Examiner further notes that KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. Examiner notes that in the current rejection, the prior art taught each element of the claim. Johnson et al. discloses a publicly accessible network, storing a record of the accepted license, and making the record available for look-up from a computer on the publicly accessible network of at least the Internet (Column 3, lines 44-57, column 8, lines 1-20, column 9, lines 35-67), as well as allowing potential licensees to access the system over the Internet (column 3, lines 44-57). Official Notice was taken (which has not been seasonably challenged) that it is well known in network security that the availability of a database to be accessed over a network is based on the security settings associated with such data. One of ordinary skill in the art at the time of the invention could have combined these teaching using known methods and each element would have performed the same function as it did separately. Specifically, combining security settings (such as making data available to anyone) with the system of Johnson et al. (where data is stored and accessible via the internet) would produce the predictable results of allowing anyone to access the data via the internet. Appellant admits on page 17 of the Appeal Brief that "this change from the prior art can easily be made by a programmer".

In response to argument 3), Examiner respectfully agrees with Appellant. Johnson et al. does not expressly disclose receiving a request for an electronic copy and that the third computer is sent via the network an electronic copy of the first work of authorship as a consequence of

having received the message. Examiner asserted that Johnson et al. taught electronic rights systems that allow for enforcement of copyrights associated with published documents and also allows for the obtainment of rights to use these documents. In Johnson et al., once the third computer (the client) accepts the terms and the acceptance is acknowledged the third computer/client, the client is allowed to access and use an electronic copy of the work via the network. See rejection above.

Examiner took official notice that it is well-known to transmit a copy of a work to a user after he has secured rights to use such a work, such as by electronic means, so that the user may have a copy of the work to use. Examiner notes that this Official notice has not been seasonably traversed by the applicant, and that these statements were taken as admitted prior art in the Final Office action of 07/05/07. Therefore, examiner maintains that it would have been obvious to one of ordinary skill in the art at the time of the invention to send via the network an electronic copy of the first work of authorship in order to more accurately account for all the aspects of conferring right (i.e. types of use, etc.) by providing fully automated rights management and authorization. See column 2, lines 40-67, column 9, lines 35-55, column 10, lines 40-60, of Johnson et al., which discloses electronic use of a document.

In response to argument 4), Examiner points out that there is a teaching, suggestion, or motivation found in Johnson to make the change suggested by Examiner Johnson et al. Examiner established that it would have been obvious to one of ordinary skill in the art at the time of the invention to send via the network an electronic copy of the first work of authorship in order to more accurately account for all the aspects of conferring right (i.e. types of use, etc.) by providing fully automated rights management and authorization. See column 2, lines 40-67,

column 9, lines 35-55, column 10, lines 40-60, of Johnson et al., which discloses electronic use of a document.

Examiner again notes that KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. Examiner notes that in the current rejection, Johnson taught a system which differed from the claimed invention. However, the substituted components and their functions were known in the prior art. Johnson et al. discloses that once a user has been granted rights to use the work, the user is able to access and uses an electronic copy of the work (as it's media of use) in figure 7, column 7, lines 1-10 and 40-55, column 9, lines 35-55, column 10, lines 40-60. Official Notice was taken (which has not been seasonably challenged) that it is well-known to transmit a copy of a work to a user after he has secured rights to use such a work, such as by electronic means, so that the user may have a copy of the work to use.

One of ordinary skill in the art at the time of the invention could have substituted the "elements" of the official notice with the "elements" of Johnson et al. and the results of such a substitution would have been predictable. Specifically, substituting a transmitted copy of a work to a user after he has secured rights to use such a work, such as by electronic means (so that the user has a local copy of the work) with the remote work used in the system of Johnson et al. (the user is able to remotely access and use an electronic copy of the work) would produce the predictable results of allowing the user to use the electronic copy.

In response to argument 5), Examiner respectfully disagrees. First, examiner notes that the claims do not recite that an electronic copy might automatically be sent to a printer, but rather

recite that the clearinghouse server system or the acceptance receiver and fulfillment component sends to a printer a copy of the work of authorship for printing on paper and delivery".

Johnson et al. teaches that a third computer (the client) accepts the teams of the license (See figures 2 and 7, column 3, lines 25-55, column 4, lines 55-67, column 9, line 35-column 10, line 15 and lines 41-60) and that the clearinghouse server system processes the order **and allows copying of the work of authorship for printing on paper.** See figure 7, column 7, lines 40-55, column 8, lines 1-22, column 9, lines 35-55, column 10, lines 40-60, wherein the third computer/client requests that they be allowed to copy the work on paper in terms of course packets. Johnson et al. specifically discloses that educational institutions are rights holders that make copies and course packets.

Examiner explicitly stated that Johnson et al. **did not expressly disclose** that the user requests that a paper reprint be delivered, sending a copy to a printer, or delivering the copy. She specifically relied on Elsevier Science to teach that the user requests a paper reprint be delivered and delivering the copy (See pages 2-3). Elsevier is a service that allows a user to order a physical copy of a publication for use. Examiner further stated that while Elsevier Science allows users to request published material and have that material delivered, Elsevier Science does not expressly disclose sending a copy to a printer.

Examiner took official notice that systems that provide requested publications make copies of these publications at their printers before sending these copies to requesters (i.e. a system that allows users to request copies of publications and have that material delivered would have to makes copies before sending copies). Examiner notes that Appellant has a not challenged this assertion in any of the previous response and thus this official notice has been

taken as admitted prior art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to send a copy to a printer before sending out the copy to the requester of Elsevier Science in order to increase the processing speed of the system of providing publications to requesting users. See page 2 of Elsever Science.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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